

Atty. Docket: 2884 (203-3592PCTUS)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: Bruce Jankowski, *et al.* **EXAMINER:** Gloria R. Weeks
SERIAL NO.: 10/540,197 **GROUP:** 3721
FILED: June 20, 2005 **DATED:** January 20, 2009
FOR: VACUUM ASSISTED SURGICAL STAPLER

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir(s)/Madam(s):

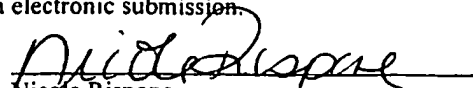
The present Pre-Appeal Brief Request is submitted in response to the Final Office Action that was mailed on September 11, 2008 and the Advisory Action that was mailed on December 5, 2008 in connection with the above-identified application. A Notice of Appeal has been filed concurrently herewith. Claims 6-12 and 19-28 are currently pending.

In the Final Office Action, Claims 6, 19, 20, and 26 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,839,639 to Sauer *et al.* ("Sauer"). This rejection was maintained in the Advisory Action.

CERTIFICATE OF TRANSMISSION UNDER 37 C.F.R. §1.8(a)

I hereby certify that this correspondence is being transmitted on the date below with the United States Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313-1450, via electronic submission.

Dated: January 20, 2009


Nicole Risponne

The Examiner's argument relies upon Sauer's handle housing 12 for disclosure of both the "housing" of the "vacuum device" and the "vacuum chamber" recited in independent claim 6¹. Applicants respectfully submit, however, that a single element of Sauer cannot properly be relied upon for the disclosure of two separate and distinct elements of the "surgical stapling apparatus and vacuum system" recited in the claims. This is particularly true when the recited elements differ greatly in structure and function, i.e., the recited "housing" constitutes a component of the structure effectuating the creation of a vacuum, whereas the recited "vacuum chamber" provides an internal space that can be depressurized upon the connection of a vacuum source². Accordingly, and without acknowledging the accuracy or propriety of the Examiner's analogies, Applicants respectfully submit that Sauer is either devoid of the recited "housing" of the "vacuum device" or the recited "vacuum chamber." In either scenario, Applicants respectfully submit that the Examiner's rejection fails to establish a *prima facie* case of anticipation under 35 U.S.C. §102(b).

Moreover, Applicants draw attention to the fact that "housing" of the "vacuum device" is recited as defining, at least partially, the recited "vacuum chamber." Given the Examiner's characterization of Sauer's handle housing 12 as both the recited "housing" of the "vacuum device" and the "vacuum chamber," upholding the Examiner's rejection would be tantamount to an endorsement of the statement that Sauer's handle housing 12 defines the handle housing 12.

¹ See Final Office Action, page 2.

² See, e.g., page 11, line 16 – page 12, line 10.

Additionally, the Examiner's argument relies upon Sauer's air delivery tube 60 for disclosure of both the "at least one aperture" included in the "shell assembly" and the "at least one vacuum tube" recited in independent claim 6³, again relying upon a single element of Sauer, i.e., the air delivery tube 60, for the disclosure of two separate and distinct elements of the "surgical stapling apparatus and vacuum system" recited in the claims. Accordingly, and without acknowledging the accuracy or propriety of the Examiner's analogies, Applicants respectfully submit that Sauer is also devoid of either the recited "at least one aperture" included in the "shell assembly" or the "at least one vacuum tube," and therefore, that the Examiner's rejection fails to establish a *prima facie* case of anticipation under 35 U.S.C. §102(b).

In view of these deficiencies in the Examiner's argument, Applicants respectfully submit that the rejection of Claims 6, 19, 20, and 26 under 35 U.S.C. §102(b) is legally insufficient, and therefore, that the rejection cannot be properly maintained.

Furthermore, Applicants draw attention to the disclosure in Sauer indicating that the "vacuum passage 58 . . . extends between the vacuum connection port 24" and that the "air delivery tube 60," which "provide[s] a source of vacuum or suction to the collapsible anvil assembly 20," (col. 7, lines 28-33), and that once a source of vacuum is connected to the vacuum connection 24 and turned on, "it creates a source of vacuum through vacuum passage 58 and thus through air delivery tube 60." (Col. 9, lines 63-64). Thus, the created vacuum extends from the source to the anvil assembly 20 through the vacuum passage 58 and the air delivery tube 60. None of these components, i.e., neither the vacuum passage 58 nor the air

³ At page 2 of the Final Office Action, the Examiner states that "the at least one aperture 60 is positioned within the vacuum chamber" and that the "at least one vacuum tube 60, 70 has a first end 60 positioned within the vacuum chamber and a second end 70 positioned within an inner chamber of the shell assembly 18."

delivery tube 60 includes any perforations, apertures, or other structure that would increase the size of the space being depressurized. Accordingly, Applicants respectfully submit that proximally of the anvil assembly 20, the vacuum exists solely within the confines of the vacuum passage 58 and the air delivery tube 60, and as such, that the only structure in Sauer possibly comparable to the recited “vacuum chamber” lies within and between the vacuum connection port 24, the vacuum passage 58, and the air delivery tube 60. However, as can clearly be appreciated through reference to FIG. 2 of Sauer, this structure is not defined between the handle housing 12 and the outer tube 18, which were respectively characterized by the Examiner as the “housing” of the “vacuum device” and the “shell assembly” recited in the claims. Therefore, Applicants respectfully submit that Sauer fails to disclose, or even suggest, “a vacuum device including a housing . . . positioned about at least a portion of the shell assembly of the surgical stapling apparatus to define a vacuum chamber,” as recited in independent Claim 6. In contrast, Sauer’s instrument merely has a central bore 114 in anvil shaft 70 and vacuum holes 112 which radiate outwardly from central bore 114.

Applicants also request reconsideration of the arguments presented in the Amendment dated November 12, 2008 that was filed in response to the Final Office Action. Specifically, Applicants maintain that the Examiner’s arguments mischaracterize the outer tube 18 of Sauer’s applicator 10, the disclosed cartridge housing 23, and the handle housing 12⁴. Additionally, Applicants maintain that Sauer also fails to disclose “at least one vacuum tube having a first end positioned within the vacuum chamber and a second end positioned within an inner chamber of the shell assembly.”⁵

⁴ See Amendment of November 12, 2008 at page 9.

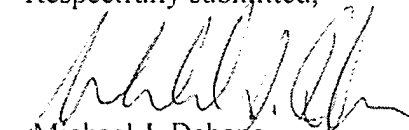
⁵ See Amendment of November 12, 2008 at pages 9-10.

For at least these reasons, *inter alia*, Applicants respectfully submit that Sauer fails to disclose each and every element recited in Claims 6, 19, 20, and 26. Therefore, Applicants respectfully submit that Sauer fails to anticipate Claims 6, 19, 20, and 26, and that these claims are in condition for allowance.

Claim 7 was also rejected in the Final Office Action under 35 U.S.C. § 103(a) over Sauer. However, given the direct dependency of Claim 7 from Claim 6, for at least the reasons discussed above with respect to Claim 6, Applicants submit that Claim 7 is patentable over Sauer and in condition for allowance.

In view of the foregoing remarks and arguments, Applicants respectfully submit that pending Claims 6-12 and 19-28 are allowable, and accordingly, respectfully request reconsideration and allowance of these claims.

Respectfully submitted,



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